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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT		ATTORNEY DOCKET NO.
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EXAMINER	
SCHAIN, M	
ART UNIT	PAPER NUMBER
153	#11

DATE MAILED: 05/21/85

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☑ Responsive to communication filed on 12/5/83 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ ~~days~~ from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449
4. ☐ Notice of informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☑ Claims 20-25 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☑ Claims 1-19 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☑ Claims 20-25 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless-
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 20-25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sharon et al., Rosemblatt et al. or Pawlowski et al. for the reasons given at the bottom of page 5 and top of page 6 of Paper No. 5 mailed June 6, 1983.

Claims 20-25 are rejected under 35 U.S.C. 103 as being unpatentable over Zakut et al., Seidman et al., or Early et al (cell), in view of Amster et al. for the reasons given at page 6 of Paper No. 5.

Claims 20-25 are rejected under 35 U.S.C. 103 as being unpatentable over Zakut et al., Seidman et al, or Early et al (Cell) in view of Amster et al as applied to claims 20-25 above, and further in view of either applicants' admitted state of the prior art (page 40, first full paragraph) or Ptashne et al for the reasons given at page 7 of Paper No. 5.

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20-25 are rejected under 35 U.S.C. 101 because the invention as disclosed is inoperative and therefore lacks utility for the reasons given at pages 2-3 of Paper No. 5.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

See first full paragraph of page 3 of Paper No.5.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to provide an enabling disclosure for claims 20-25 as explained in the second full paragraph of page 3 of Paper No. 5.

Claims 20-25 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the above objection to the specification.

Claims 20-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

See last seven lines of page 3 and top 10 lines of page 4 of Paper No. 5.

Claims 20-25 are rejected under 35 U.S.C. 102(b) or (e) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Ehrlich et al. or Auditore.

Regardless of method of preparation the immunoglobulins of claim 20 are indistinguishable from the immunoglobulins or antibodies described by Ehrlich and by the prior art (35 USC 102(b)) summarized by Auditore in col. 1 and top of col. 2 of her patent.

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5/15/85

HOWARD E. SCHAIN
PATENT EXAMINER
GROUP 150 - ART UNIT 153

Howard E. Schain